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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,012

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EXAMINER

DYE, ROBERT C

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,012	Applicant(s) WATSON ET AL.	
	Examiner ROBERT DYE	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13, 15-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is a non-final Office action in response to Applicant's response dated 2/18/2009 to a non-final Office action. Claims 2-13 are pending, with claims 2-9 amended and claims 1 and 14 cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6 and 8 recite the limitation "the second sign" in line 3 of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 2-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Abrams et al. (USP 5,800,757).

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7. Abrams et al. (hereinafter Abrams) teach a sign with a sheet or film 204 containing a graphics side that is integrally molded onto a planar substrate material 16 (see figure 17) and contains holes 220 on the rear side for mounting to a frame or pole (col 19, lines 12-13, figure 20).

8. Regarding the flexible thermoplastic substrate, Abrams teaches that the label can be formed of a plastic sheet such as Teslin (col 20, lines 50), which is known to be a flexible thermoplastic material (the material is commonly used for laminating plastic identification cards or in passports). Although the claims cite the use of an injection molding method rather than a compression molding method as taught by Abrams to form the planar substrate which is fused to the label, the Examiner wishes to point out to applicant that claims 2-8 are directed towards a product and as such will be examined under such conditions. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (See MPEP 2113). Abrams discloses that molten thermoplastic material is integrally molded to a label under pressure by a compression device as opposed to an injection device. Although injection molding device is not used, the final structure of the product is substantially the same (label fused to substrate).

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8. Regarding claim 3, Abrams teaches that the sign contains holes 220 (mounting feature) on the rear side (figure 20) for mounting the sign to a frame or pole (securing to a post) (col 19, lines 10-15).

9. Regarding claim 4, Abrams teaches that the sign contains a plurality of ribs 202 which facilitates strengthening the sign (col 18, lines 44-47).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams et al. (USP 5,800,757).

10. Regarding claim 5, wherein the second object is a second sign, the Abrams teaches a point of use promotion sign (figure 21). Abrams does not disclose a two-sided sign. However, since it is well-known in the marketing industry to use two-sided point of use promotion signs to attract customers from two directions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to connect the promotional sign of Abrams to another molded identical promotional sign in order to attract customers from two directions.

11. Claims 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams et al. (USP 5,800,757) in view of Eberle et al. (USP 6,131,320) or Weiner et al. (USP 4,541,190).

12. Regarding claim 6, wherein the mounting feature is a male snap element adapted to mate with a corresponding female snap element, Abrams does not teach a male snap element. However, male and female snap elements are well known in the molding art as an effective means for connection. For example, Eberle et al. (abstract) and Weiner et al. (col 4, lines 20-25) disclose male and female snap element for securing sign portions together. It would have been obvious to a person having ordinary

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skill in the art at the time the invention was made to use a male snap element in the sign of Abrams in order to efficiently and effectively connect the signs.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams et al. (USP 5,800,757) in view of Bowers et al. (PG Pub 2003/0154639).

14. Regarding claim 7, Abrams teaches a sign with a label integrally molded onto planar substrate and a mounting feature for securing the sign. Abrams does not teach a sign with an end extending between the front and back side that includes mounting features for securing the sign to a second sign. In the same field of endeavor of sign manufacture, Bowers et al. teach a sign having a front with a label and a back side. In one embodiment, Bowers et al. teach a sign with an extending end having mounting features for connection to a second sign (see figure 7, wherein mounting brackets 46a, 46b connect two display signs, and paragraph 33). The configuration of this embodiment would place the labels on each sign directly next to each other such that they are contiguous. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to connect the signs end to end as taught by Bowers et al. in the method of Abrams for the purpose of increasing the customizability of the sign and allow for more diverse messages to be displayed to attract or inform persons.

15. Claim 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abrams et al. (USP 5,800,757) in view of Bowers et al. (PG Pub 2003/0154639) and Wardle (USP 4,137,657)

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16. Regarding claim 8, Abrams in view of Bowers discloses a second sign attached next to a first sign for the purpose of increasing the customizability of the sign (see above). In regards to a groove, such is well-known in the molding art as an effective means for connection. For example, Wardle discloses a display wherein grooves are located at the edges to permit mating between the plural displays (Fig. 1). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a groove as taught by Wardle in the sign of the hypothetical combination of Abrams and Bowers in order to efficiently and effectively connect the signs. An advantage of the groove would be the provision of a flat surface to permit the effective use of adhesives (col 4, lines 7-9).

13. Claim 9, 10, 11, 12, 15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts (WO03/016017) in view of Abrams et al. (USP 5,800,757).

14. Alberts discloses a method for injection molding a product containing a label wherein said method comprises the steps of providing a first and second mold portion located opposite from one another (mold portions 6 and 8); associating an injection device with the first mold portion (supply duct 16 is associated with injection molding machine shown schematically as pump 18, Fig 4, 5); associating an ejector system with first sign mold portion (Alberts teaches that the transfer part 38 is provided to remove the formed product 48 from the first mold cavity 14 but that optionally, an ejection means can be provided in the mold cavity 14 with the advantage of removing the product in a simpler manner without the product sustaining damage, pg 7, lines 21-25;

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Alberts teaches that conventional ejection pins can be employed in cavity 14, pg 12, lines 7-11); placing a label 60 on the second mold portion 8 (see fig. 5, pg 8, lines 1-6); closing the first and second mold portions together and injecting the first sign mold portion via the injection device (pg 8, lines 7-16), and removing the previously formed sign prior to mold closing (pg 8, lines 7-8).

15. With regards to the ejector system contacting the formed sign on the side opposite the label, such would be inherent in the method of Albert which locates the ejector system and formed material in mold cavity 14, which is opposite side 62 onto which the label is placed (see Fig 5).

16. Alberts does not teach the method for use in the manufacture of signs. In the same field of endeavor of molding thermoplastic articles with sheet-like inserts, Abrams et al. (hereinafter Abrams) teaches that a sign (point-of-purchase sign, col 20, lines 33-34) may be produced via the use of a printed label as the insert in a molding operation (see figure 17 and 21). It would have been obvious to a person having ordinary skill in the art to produce a sign as taught by Abrams with the method of Alberts in order to form a diverse article capable of attracting customers and relaying information.

17. Regarding claims 10 and 11, Alberts teaches that the automated transfer device moves between first and second mold portions to simultaneously place a label and remove a formed product (pg 2, lines 17-26; pg 7, line 6- pg 8, line 16; Fig 5).

18. Regarding claim 12, Alberts teaches that the material is injected through channel 16 into the first mold cavity (pg 5, lines 5-10, 18-23; Fig. 5).

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19. Regarding claim 15, Alberts discloses an automated transfer device which places labels and removes formed products. Alberts teaches that said transfer device includes guiding means which are adapted to mate with guidance members on the molding portion (see rails or slots 22 shown in Fig. 5 and 7). Although the guidance members are shown as being associated with the first mold portion (which Alberts describes as the stationary part of the mold), Alberts teaches that the guidance members can also be included in the movable part (pg 12, lines 5-7). Alberts also discloses a mold design wherein the guidance system is on the second mold portion (see Fig 10, first portion denoted by injection system 16 and 18).

20. Regarding claim 19, Alberts discloses that multiple labels can be placed within the second mold portion via multiple transfer devices (see Fig 8, 9; pg 9, lines 22-pg 10, 20).

21. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts (WO03/016017) in view of Abrams et al. (USP 5,800,757) as applied to claim 12 above, and further in view of Assalita et al. (USP 5,922,367, of record).

22. The hypothetical combination of Alberts and Abrams does not teach a method wherein a heated sprue bushing is used to eliminate the need to manually trim the sign. In the same field of endeavor of injection molding, Assalita et al. (hereinafter Assalita) teach the use of a heated sprue bushing in an injection mold for the purpose of reducing material waste by preventing material from solidifying within the sprue busing (col 1, lines 44-47; col 4, lines 67-68). Assalita further teaches that the sprue material, if

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allowed to solidify, has to be removed from the part and discarded (col 1, lines 32-35).

Thus, it would have been obvious to a person having ordinary skill in the art at the time of the invention to employ a heated sprue bushing as taught by Assalita in the method of Alberts and Abrams for the purpose of reducing material waste and eliminating the need to remove excess sprue material from the formed part (col 1, lines 44-47; col 4, lines 67-68).

17. Claim 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts (WO03/016017) in view of Abrams et al. (USP 5,800,757) as applied to claim 15 above, and further in view of Hasl et al. (USP 4,880,368).

18. The hypothetical combination of Alberts and Abrams does not teach a method wherein the label hopper contains a guidance member adapted to mate with the automated device responsible for transferring labels to the mold. In the same field of endeavor of in-mold labeling, Hasl et al. teaches a label hopper with fingers 92 and 92a which adapt to mate with the cutouts 86 in the heads of 75 (label transfer device) (see figure 4, col 9, lines 46-50) for the purpose of aligning the label transfer device with the labels. Thus, it would have been obvious to a person having ordinary skill in the art at the time of the invention to have used guidance members on the label hopper as taught by Hasl et al. in the method of Alberts and Abrams for the purpose of aligning the automated label transfer device.

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19. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts (WO03/016017) in view of Abrams et al. (USP 5,800,757) and Hasl et al. (USP 4,880,368) as applied to claim 16 above, and further in view of Hellmer et al. (USP 4,397,625).

20. Regarding claim 17, the hypothetical combination of Alberts, Abrams and Hasl et al. teach a method for manufacturing a sign via in-mold labeling as described above in claim 16, but does not teach a method wherein the orientation of the label is adjusted on the label hopper. In the same field of endeavor of methods for manufacturing products via injection molding with in-mold inserts, Hellmer et al. (hereinafter Hellmer) teach a method wherein a label hopper is provided with mechanisms designed to hold a label in a particular orientation (see figure 3). Hellmer teach that a "labels L are maintained at a preset orientation by a plurality of elongated guide rods 64 which are arranged in accordance with the configuration of the particular label" (col 3, lines 35-43). Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have used orientation adjustment mechanisms as taught by Hellmer in the method of the aforementioned combination for the benefit of holding the labels in a preset orientation for pick up and accurate placement by the label transfer means.

23. Regarding claim 18, wherein the adjustment mechanism is used that can adjust in a lateral direction, a vertical direction and rotational direction, Hellmer et al. does not explicitly describe the directions with which the guidance rods can be arranged.

However, Hellmer does state that the guidance rods are positioned in accordance with

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the configuration of the particular label (col 3, lines 35-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to position the guidance rods of Hellmer as necessary in a lateral, vertical or rotational direction in the hypothetical combination of Alberts, Abrams and Hasl for the benefit of ensuring an accurate placement of the insert in the molding device.

Response to Arguments

24. Applicant's arguments with respect to claim 2 have been fully considered but they are not persuasive.

25. The Applicant has amended the claim to require that the label be formed of "flexible thermoplastic substrate" and that the molding material is injection molded onto the label. Regarding the flexible thermoplastic substrate, Abrams teaches that the label can be formed of a plastic sheet such as Teslin (col 20, lines 50), which is known to be a flexible thermoplastic material (the material is commonly used for laminating plastic identification cards or in passports). Regarding the use of an injection molding method rather than a compression molding method to form the planar substrate which is fused to the label, the Examiner wishes to point out to applicant that claims 2-8 are directed towards a product and as such will be examined under such conditions. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

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though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (See MPEP 2113). Abrams discloses that molten thermoplastic material is integrally molded to a label under pressure by a compression device as opposed to an injection device. Although injection molding device is not used, the final structure of the product is substantially the same (label fused to substrate).

26. Applicant’s arguments, see pg 8, with respect to the rejection of claim 9 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Alberts (WO03/016017) in view of Abrams et al. (USP 5,800,757).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT DYE whose telephone number is (571)270-7059. The examiner can normally be reached on Monday to Friday 8:00AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Joseph S. Del Sole can be reached on (571)272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RCD

/Joseph S. Del Sole/
Supervisory Patent Examiner, Art Unit 1791